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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,856	07/31/2003	Dale W. Kohler	STX-012	9080
28970	7590	06/17/2004	EXAMINER	
SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			CHAMBERS, MICHAEL S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/630,856	<b>Applicant(s)</b> KOHLER ET AL.	
	<b>Examiner</b> Michael Chambers	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.  
     4a) Of the above claim(s) 32-37 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-19 and 21-31 is/are rejected.  
 7) ☒ Claim(s) 20,24 and 25 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-31 are, drawn to lacrosse heads with articulated sidewalls, classified in class 473, subclass 513.
- II. Claim 32- 37 are drawn to rackets with articulated stops, classified in class 473, subclass 505.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility in that it can be used with a fixed stop and invention II can be used with a fixed sidewall. See MPEP § 806.05(d).

During a telephone conversation with Steve Arnheim on June 10, 2004, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-17, 21-23 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir in view of Tucker et al (5566947). Muir discloses the elements of claim 1, however it fails to disclose the use of a second sidewall. Tucker discloses the use of a second sidewall. Second sidewalls are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the sidewall of Tucker with the apparatus of Muir in order to increase sales by producing a lacrosse head with a modern and well known shape. The first member of the sidewall is item 7, fig 2. And the second member that is moveable and has a thread opening is item 13, fig 2.

As to claim 2: Muir discloses thread openings configured to receive a thread (fig 1).

As to claims 3 and 12: Muir discloses a pocket (fig 1).

As to claim 6: Muir discloses a first member height with the sum of the second and third height is no greater than the first height (fig 3).

As to claim 7: Muir discloses a hinge (fig 3). The fabric section that forms item 13 will act as a hinge.

As to claim 8: Muir discloses a second member disposed at the back face (fig 4, 13 is at the back of the head).

As to claim 9: Muir discloses a shaft (fig 1, item 5).

As to claim 10: Muir discloses a second member is an interior portion (fig 2).

As to claim 11: Tucker discloses the use of a second sidewall (fig 1). Second sidewalls are well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the sidewall of Tucker with the apparatus of Muir in order to increase sales by producing a lacrosse head with a modern and well known shape. The first member of the sidewall is the upper unnumbered sidewall , fig 1. And the second member that is moveable and has a thread opening is shown in Muir, item 13 fig 1. The third member of the sidewall is lower unnumbered sidewall , fig 1. And the fourth member that is moveable and has a thread opening is shown in Muir, item 13 fig 1.

As to claims 13 and 14: Tucker et al discloses a stiffening member (fig 4 72,60,76) It would have been obvious to one of ordinary skill in the art to have used a stiffening member in order to strengthen the head and increase the life of the head.

As to claims 15 and 17: Tucker et al discloses an opening (fig 4, item 67) that can be used to receive a thread.

As to claim 16: Tucker et al discloses an triangular gusset (fig 4, item 60).

As to claims 21 and 22: No criticality is seen in the materials selected. The materials are well known in the art. The specification provides no unexpected results in using the materials cited. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent materials based on design and cost considerations.

As to claim 23: Muir discloses a second member is affixed to the first member (fig 2).

As to claim 26: Muir discloses a first and second member coupling holes (11,12 fig 1).

As to claim 27: See claim 1 rejection.

As to claim 28: See claim 2 rejection.

As to claim 29: See claim 3 rejection.

As to claim 30: See claim 7 rejection.

As to claim 31: See claim 10 rejection.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir in view of Tucker and further in view of applicant's admitted prior art. The cited art does not clearly disclose the elements of claim 1, however it fails to disclose the height of the sidewall. The applicant admits that in order for the lacrosse head to be legal, the maximum height of the sidewall is less than 2" (page 3 paragraph 007 ). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the dimensions cited in order to increase sales by producing a legal lacrosse head.

As to claim 5 : The specification provides no unexpected results in using the dimensions cited. It would have been obvious to one of ordinary skill in the art to have selected any one of several appropriate heights based on design and cost considerations.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir in view of Tucker and further in view of Tucker (5082290). The cited art discloses the elements of claim 18, however it fails to disclose a connector. Tucker discloses a connector adapted to join the head to a hollow shaft (fig 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have

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employed the connector of Tucker with the device in order to permit an easy changing of a broken head.

As to claim 19: Tucker discloses a plug with compressible ribs (item 20- un-numbered attachment ribs).

### ***Allowable Subject Matter***

Claims 20 and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

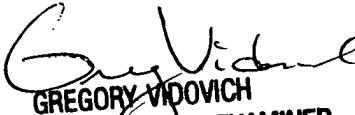
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GB424742\*5566947\*5082290

Michael Chambers  
Examiner  
Art Unit 3711

June 14, 2004

  
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